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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,919	05/29/2001	Akiyuki Yoshisato	9281-3961	7545

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Brinks Hofer Gilson & Lione  
P.O. Box 10395  
Chicago, IL 60610

EXAMINER
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GRAYBILL, DAVID E

ART UNIT	PAPER NUMBER
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2827

DATE MAILED: 11/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/867,919

Applicant(s)

YOSHISATO ET AL.

Examiner

David E Graybill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 May 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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In the rejections infra, reference labels are generally recited only for the first recitation of identical claim language.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Pedder (5784261).

At column 1, lines 16-30, column 1, line 61 to column 2, line 8, column 2, line 25 to column 3, line 48, and column 4, line 60-65, Pedder teaches the following:

1. An electronic-circuit unit comprising: an alumina board 1; circuit elements comprising a capacitor, a resistor, and an inductive device, are formed as thin films on the alumina board; an electrically conductive pattern connected to at least one circuit element is formed as a thin film on the alumina board; a semiconductor bare chip 3 is mounted on the alumina board; and an end-face electrode 8 connected to the electrically conductive pattern is formed on a side face of the alumina board, wherein

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the semiconductor bare chip is wire-bonded 4 to the electrically conductive pattern.

4. An electronic-circuit unit according to 3, wherein an Au plating layer is formed on the end-face electrode.

5. An electronic-circuit unit according to 3, wherein the end-face electrode is formed as a thick film only at each of two sides along opposing edges of the alumina board (see the drawing.)

6. An electronic-circuit unit according to 4, wherein the end-face electrode is formed as a thick film only at each of two sides along opposing edges of the alumina board.

7. An electronic-circuit unit comprising: circuit element comprising a capacitor, a resistor, and an inductive device, formed as thin films on an alumina board having a rectangular, plane shape; a semiconductor bare chip wire-bonded on the alumina board; grounding electrodes 8 formed at the ends of two sides along opposing edges of the alumina board; and an input electrode and an output electrode formed away from the ends.

8. An electronic-circuit unit according to 7, wherein a shielding cover 9 is mounted to the alumina board so as to cover the circuit elements and the semiconductor bare chip, the shielding cover being soldered to the grounding electrodes.

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To further clarify the teaching of an input electrode and an output electrode formed away from the ends, as cited, Pedder teaches electrode "connections within the substrate area." Moreover, the limitations "input" and "output" are statements of intended use of the product which does not result in a structural difference between the claimed product and the product of Pedder. Further, because the product of Pedder has the same structure as the claimed product, it is inherently capable of being used for the intended use, and the statement of intended use does not patentably distinguish the claimed product from the product of Pedder. Similarly, the manner in which a product operates is not germane to the issue of patentability of the product; Ex parte Wikdahl 10 USPQ 2d 1546, 1548 (BPAI 1989); Ex parte McCullough 7 USPQ 2d 1889, 1891 (BPAI 1988); In re Finsterwalder 168 USPQ 530 (CCPA 1971); In re Casey 152 USPQ 235, 238 (CCPA 1967). And, claims directed to product must be distinguished from the prior art in terms of structure rather than function. In re Danley, 120 USPQ 528, 531 (CCPA 1959). "Apparatus claims cover what a device is, not what a device does [or is intended to do]." Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

However, Pedder does not appear to explicitly teach the following:

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3. An electronic-circuit unit according to 1, wherein the end-face electrode is formed as a thick film by the use of a low-temperature baked material.

Nonetheless, the product of Pedder inherently possesses the structural characteristics imparted by this process limitation. See *In re Fitzgerald, Sanders, and Bagheri*, 205 USPQ 594 (CCPA 1980).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35

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U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pedder as applied to claims 1 and 3-8, and further in combination with Erdeljac (20010019865) and Dow (5478773).

Pedder does not appear to explicitly teach the following:

2. An electronic-circuit unit according to 1, wherein a Cu layer is formed on a surface of the capacitor and the inductive device.

Notwithstanding, at paragraph 0090, Erdeljac teaches wherein a Cu layer is formed on a surface of a capacitor, and at column 5, lines 46-64, Dow teaches wherein a Cu layer is formed on a surface of an inductor. Furthermore, it would have been obvious to combine the products of the applied prior art because it would improve unit quality.

The art made of record and not applied to the rejection is considered pertinent to applicant's disclosure. It is cited primarily to show inventions similar to the instant invention.

***Any telephone inquiry of a general nature or relating to the status (MPEP 203.08) of this application or proceeding should be directed to Group 2800 Customer Service whose telephone number is 703-306-3329.***

Any telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (703) 308-2947. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m.

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The fax phone number for group 2800 is 703/3087724.



David E. Graybill  
Primary Examiner  
Art Unit 2827

D.G.  
6-Nov-02